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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,377	02/18/2000	Miki Yamada	04329.2231	8206

22852 7590 04/22/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

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DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,377

Applicant(s)

YAMADA ET AL.

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-7 and 9-19 is/are allowed.
- 6) ☒ Claim(s) 4 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-19 have been examined. Claims 1 and 5-10 have been amended in response to the first office action.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: item "17" on page 12, line 16. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. In view of applicant's amendments, all claim objections are withdrawn.

Claim Rejections - 35 USC § 112

4. In view of applicant's amendments, all previous rejections under 35 U.S.C. 112 are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,790,668 to Tomko.

Tomko discloses a transaction system that includes a smartcard (which contains a computer chip and computer-readable medium) that registration data in a PIN, performs an encryption based on the PIN and biometric input data, such as a fingerprint, and passes an encrypted result to a main processor. See column 4, line 52 to column 5, line 5.

Tomko further discloses a main processor, which is communicatively connected to the portable unit, for receiving the enciphered text from the portable unit, has the ability to input information, decrypt received ciphertext, and compare the information to data from a database. See column 4, line 38 to column 5, line 53.

Claim Rejections - 35 USC § 103

6. All previous rejections under 35 U.S.C. 103 are withdrawn.

Response to Arguments

7. Applicant's arguments, see Paper No. 9, filed 19 February 2004, with respect to claims 1-7 and 9-19 have been fully considered and are persuasive.

Regarding claims 1-7, 9, and 10, the additional limitation added in each claim overcomes the previous rejections under 35 U.S.C. 102 and 35 U.S.C. 103. No obvious modification to Tomko can be found that would render the claims unpatentable. The rejections of the claims have been withdrawn.

Regarding claim 11-17, Applicant correctly argues that Tomko does not encrypt the registration data when the personal authentication is to be performed; this is done previously.

Regarding claims 18 and 19, Applicant correctly argues that Tomko does not decrypt the registration data before re-encrypting it.

8. Regarding claims 4 and 8, Applicant's arguments filed 19 February 2004 have been fully considered but they are not persuasive.

Regarding all of the claims, in response to applicant's argument that the invention of Tomko serves a different purpose than the invention of the instant application, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 8, in response to applicant's arguments, the argued recitations have not been given patentable weight because the recitations occur in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claims 4 and 8, the phrasing of the claims regarding decryption is broader than that of claim 1. The claims as now delimited are anticipated by the cooperative decryption scheme of the personal units disclosed by Tomko.

Allowable Subject Matter

9. Claims 1-3, 5-7 and 9-19 are allowed.

10. The following is an examiner's statement of reasons for allowance:

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Regarding claims 1-3, 5-7, 9, and 10, the closest art, U.S. Patent No. 5,790,668 to Tomko, uses a double encryption scheme that makes it impossible for the personal authentication units to fully decrypt the registration data by themselves; moreover, the modification of Tomko to a different encryption scheme would render it useless.

Regarding claim 11-17, Tomko does not encrypt the registration data when the personal authentication is to be performed; this is done previously. Because of Tomko's double encryption, it would be infeasible to encrypt the data on the fly.

Regarding claims 18 and 19, Tomko does not decrypt the registration data before re-encrypting it, as this would be impossible under the Tomko's double encryption.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,697,947 to Matyas, Jr. et al. discloses a system for authentication messages among multiple users using biometric information.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday-Thursday from 9:00 AM - 5:00 PM Eastern Time. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MEH *MCH*
April 19, 2004

Gregory Morse
GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100